IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

ABBOTT GMBH & CO., KG, AND ABBOTT BIORESEARCH CENTER, INC. Plaintiffs, v. CENTOCOR ORTHO BIOTECH, INC., Defendant.	)	Civil Action No. 4:09-cv-11340-TSH **Jury Trial Demanded**

ADDITIONAL STATEMENT OF ABBOTT REGARDING CASE SCHEDULE

In advance of the February 25, 2010 scheduling conference, Abbott respectfully requests that the Court consider the following in setting a schedule with respect to the three pending actions:

There are significant Seventh Amendment concerns implicated by Centocor's request to phase the proceedings such that a bench trial on the equitable claims raised in its Section 146 action would occur prior to Abbott's legal claims for patent infringement and damages. *See, e.g., Shum v. Intel Corp*., 499 F.3d 1272, 1277-79 (Fed. Cir. 2007) (Seventh Amendment required jury determination of inventorship issue, which was common to equitable claim under 35 U.S.C. § 256 and state law fraud claims). Here, Centocor has raised, *inter alia*, the following issues in its Section 146 action:

- Centocor asks the Court to reverse the PTO's denial of its motion in the interference proceeding that certain claims of Abbott's ’128 patent are invalid as obvious under 35 U.S.C. § 103(a).
- Centocor asks the Court to reverse the PTO's grant of Abbott's motion in the interference proceeding that Abbott was the first to invent the subject matter of the interference count and the award of priority of invention to Abbott.

Similarly, in its answer and counterclaims to Abbott's complaint for infringement of the ’128 and ’485 patents, Centocor has raised affirmative defenses and counterclaims which assert that the Abbott patents are invalid under multiple provisions of the Patent Act, including Sections 102 (anticipation) and 103 (obviousness). *See* Centocor's 9/15/09 Answer and Counterclaims, 3rd and 5th affirmative defenses, 3rd and 4th counterclaims. Centocor has made identical allegations in its separate complaint seeking, *inter alia*, a declaratory judgment of invalidity of the ’128 and ’485 patents. *See* Centocor's 8/28/09 Complaint, Counts III and IV.

Since Centocor's Section 146 action and its defenses and counterclaims to Abbott's infringement action both raise the issue of alleged invalidity for obviousness, Abbott would be entitled to have a jury decide this claim in advance of any determination by the Court on this same issue in the Section 146 action. Moreover, to the extent that Centocor's claims for invalidity of Abbott's patents due to alleged prior invention by Centocor overlap in the Section 146 action and in Abbott's action for infringement, the Seventh Amendment would also require that those claims be first decided by a jury.

At this early stage of the proceedings, before discovery has commenced, the Court need not decide the precise issues required to be first and collectively tried under the Seventh Amendment. Instead, those issues can and should be decided after the close of discovery. For this reason, Abbott's proposed schedule, which permits a unified discovery period on all issues, with early preliminary infringement and invalidity contentions, is the most logical and efficient use of the Court’s and parties’ resources. Centocor’s proposal of phased discovery not only requires the Court to decide the Seventh Amendment issues now but in a manner that would be error under the *Shum* decision. Accordingly, for the reasons set forth herein and in Abbott's portion of the February 18, 2010 L.R 16.1 Joint Statement, Abbott requests that the Court adopt

its proposal for unified discovery and defer a determination with respect to the scope and order of trials until the issues have been clarified in discovery.

Respectfully submitted,

February 23, 2010

/s/ William F. Lee

William F. Lee (BBO #291960)
WILMER CUTLER PICKERING
HALE AND DORR LLP
60 State Street
Boston, Massachusetts 02109
Tel: (617) 526-6000
Fax: (617) 526-5000
Attorney for Abbott GmbH & Co., KG, and Abbott Bioresearch Center, Inc.

OF COUNSEL:

Robert J. Gunther, Jr. (admitted *pro hac vice*)
Paul B. Keller (admitted *pro hac vice*)
Jane M. Love (admitted *pro hac vice*)
Violetta G. Watson (admitted *pro hac vice*)
WILMER CUTLER PICKERING
HALE AND DORR LLP
399 Park Avenue
New York, New York 10022
Tel: (212) 230-8800
Fax: (212) 230-8888

Amy K. Wigmore (admitted *pro hac vice*)
Nina S. Tallon (admitted *pro hac vice*)
Amy J. Nelson (admitted *pro hac vice*)
Meaghan Davant (admitted *pro hac vice*)
WILMER CUTLER PICKERING
HALE and DORR LLP
1785 Pennsylvania Avenue, NW
Washington, DC 20006
Tel: (202) 663-6000
Fax: (202) 663-6363

William W. Kim (admitted *pro hac vice*)
WILMER CUTLER PICKERING
HALE and DORR LLP
1117 California Avenue
Palo Alto, California 94304
Tel: (650) 858-6000
Fax: (650) 858-6100

John T. Callahan (admitted *pro hac vice*)
Keiko K. Takagi (admitted *pro hac vice*)
William J. Simmons (admitted *pro hac vice*)
Travis B. Ribar (admitted *pro hac vice*)
SUGHRUE MION PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037
Tel: (202) 663-7387

CERTIFICATE OF SERVICE

I hereby certify that on February 23, 2010, I electronically filed the foregoing ADDITIONAL STATEMENT OF ABBOTT REGARDING CASE SCHEDULE with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

Heather B. Repicky (BBO #663347)
hrepicky@nutter.com
NUTTER MCCLENNEN & FISH LLP
World Trade Center West
155 Seaport Boulevard
Boston, MA 02210

Dianne B. Elderkin (admitted *pro hac vice*)
delderkin@akingump.com
Barbara L. Mullin (admitted *pro hac vice*)
bmullin@akingump.com
Steven D. Maslowski (admitted *pro hac vice*)
smaslowski@akingump.com
Matthew A. Pearson (admitted *pro hac vice*)
mpearson@akingump.com
AKIN GUMP STRAUSS HAUER & FELD LLP
Suite 4100
Two Commerce Square
2001 Market Street
Philadelphia, PA 19103

John F. Murphy (admitted *pro hac vice*)
jmurphy@woodcock.com
James V. Spencer (admitted *pro hac vice*)
jspencer@woodcock.com
WOODCOCK WASHBURN LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104

/s/ William F. Lee
William F. Lee